Remarks

Claims 1 and 3-5 are pending in the present application. The Examiner rejected these claims under 35 U.S.C. § 112, second paragraph, arguing that the term "method" is ambiguous. The Examiner has also rejected these claims under 35 U.S.C. § 103 based on a combination of the '491 patent with the '895 patent.

Arguments

The Examiner's rejection under 35 U.S.C. § 112, second paragraph, has no basis in law. The term "method" is well known in patent law. It is a term distinct from composition. It is not required to further specify the nature of the method or what the method seeks to achieve. The Examiner has cited no case law for the proposition that the "metes and bounds" of the term "method" are unclear. The Examiner is asked to take note of the hundreds (if not thousands) of issued claims using the term "method" without further language in the preamble. Moreover, the ENTIRE claim must be considered by the Examiner. The steps set forth are quite specific. One of skill in the art, upon reading the entire claim and the specification, understands how to carry out the method. The law requires no more. Further limitations cannot be imposed. The claim is broad enough to encompass treatment as well as prevention – or simply good nutritional health (see Claim 3).

The Examiner's rejection under 35 U.S.C. § 103 is also contrary to law. The Examiner has combined two references in order to create a 103 rejection. However, the law requires determinations as to whether a) the references can – as a technical matter – be combined, and b) there is a suggestion or teaching to make the combination. On both points the Examiner is silent (or at best conclusory). Looking at the technology in each reference, it is clear that the references cannot be combined. The Stott patent describes a method for utilizing whey, defined (at col. 5, lines 60-63) as "the liquid whey byproduct of the cheese making process as well as milk from which casein has been removed," so as to isolate an antibody-enriched fraction. The Stott patent does not contemplate other sources or starting materials. The Stott method is specific to whey and not applicable to

other antibody sources, such as those taught in the Tokoro patent. Thus, as a technical matter, the references cannot properly be combined. This is not a matter of merely adding an ingredient to the Stott process.

The Examiner argues that one would be motivated to make the combination in order to "yield mass production of inexpensive antibodies." On what basis? The Stott patent underscores the advantages of utilizing the 34,000,000 metric tons of starting material that would otherwise not be utilized (col. 5, lines 35-43). The Stott patent solution for making large amounts of "inexpensive antibodies" is to use what has already been generated – not to go out and generate more antibody by immunization. In this manner, the Stott patent teaches away from the Tokoro approach. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path . . ." U.S. v. Adams, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966). Stott teaches that one should use the antibody already present in the source (whey). Thus, one skilled in the art would be led in a different direction and would not attempt to combine the teachings of Stott with Tokoro.

CONCLUSION

Applicants believe that the arguments set forth above traverse the Examiner's rejections and, therefore, request that these grounds for rejections be withdrawn for the reasons set forth above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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